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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,258	07/11/2003	Mitsuhiko Kitagawa	81788.0252	3224

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EXAMINER

PHAM, LONG

ART UNIT

PAPER NUMBER

2814

DATE MAILED: 11/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/618,258

Applicant(s)

KITAGAWA ET AL.

Examiner

Long Pham

Art Unit

2814

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 5-8 and 11-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,9 and 32-34 is/are rejected.
- 7) ☐ Claim(s) 4 and 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                    |                                                                             |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____                                                 |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>07/11/03</u> .                                                            | 6) <input checked="" type="checkbox"/> Other: <u>labeled drawings</u> .     |

## **DETAILED ACTION**

### ***General Information***

Paper copies of cited U.S. patents and U.S. patent application publications will cease to be mailed to applicants with Office actions as of June 2004. Paper copies of foreign patents and non-patent literature will continue to be included with office actions. These cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site ([www.uspto.gov](http://www.uspto.gov)), from the Office of Public Records and from commercial sources. Applicants are referred to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197 for information on this policy. Requests to restart a period for response due to a missing U.S. patent or patent application publications will not be granted.

The labeled drawing sheet(s) of the present invention are attached to show examiner's understanding of the disclosed and claimed inventions.

### ***Election/Restrictions***

1. Applicant's election without traverse of fifth embodiment, claims 1-4, 9-10, and 32-34 in the reply filed on 10/18/04 is acknowledged.

### ***Drawings***

1. Figures 12 and 13A-13E should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 9, 32, 33, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over the applicants' admitted prior art (AAPA) of this application in combination with Hiyoshi (US 5,734,703) and Umeji (US 4,614,873).

With respect to claim 1, AAPA teaches a MEMS apparatus comprising (see The Related Art on pages 1-2 and figs. 12 and 13A-13E of this application): a MEMS assembly driven by a voltage.

AAPA fails to teach that the voltage is generated by a light-receiving circuit or device that receives light a light-emitting circuit or device.

Hiyoshi teaches using a light-receiving circuit or device that receives light a light-emitting circuit or device to generate voltage. See col. 35, lines 58-65.

It would have been obvious to one of ordinary skill in the art of making semiconductor devices to generate voltage for the apparatus of AAPA as taught by Hiyoshi because the generated voltage can be controlled by controlling the intensity of the received light. See col. 35, lines 58-65.

Further with respect to claim 1, Hiyoshi fails to teach that the light-receiving circuit has series-connected light receiving devices.

Umeji teaches connecting light receiving devices or elements in series to control the voltage. See col. 1, lines 60-68.

It would have been obvious to one of ordinary skill in the art of making semiconductor devices to connect the light receiving devices or elements in series in the apparatus of AAPA and Hiyoshi to obtain the above benefit.

With respect to claim 2, AAPA further teaches the MEMS assembly includes an RF-MEMS switch. See the Related Art on pages 1-2 and figs. 12 and 13A-13E of this application.

With respect to claim 9, AAPA also fails to teach that the MEMS apparatus includes a voltage discharge circuit.

However, the inclusion of a voltage discharge circuit is well-known to one of ordinary skill in the art of making semiconductor devices.

With respect to claim 32, AAPA also fails to teach that the MEMS apparatus includes a MEMS mirror.

However, the inclusion of a MEMS mirror is well-known to one of ordinary skill in the art of making semiconductor devices.

With respect to claim 33, AAPA also fails to teach that the MEMS apparatus includes a MEMS optical switch.

However, the inclusion of a MEMS optical switch is well-known to one of ordinary skill in the art of making semiconductor devices.

With respect to claim 34, AAPA also fails to teach that the MEMS apparatus includes a MEMS actuator.

However, the inclusion of a MEMS actuator is well-known to one of ordinary skill in the art of making semiconductor devices.

#### ***Allowable Subject Matter***

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3. Claims 4 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Long Pham whose telephone number is 571-272-1714. The examiner can normally be reached on M-F, 7:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wael Fahmy can be reached on 571-272-1705. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Long Pham  
Primary Examiner  
Art Unit 2814

LP